FISH & RICHARDSON P.C.

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number: 06975-211001 |
|---|---|---|
| I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.<br><br>Date of Deposit<br><br>Signature<br><br>Typed or Printed Name of Person Signing Certificate | Application Number: 10/059,147 | Filed: January 31, 2002 |
| | First Named Inventor: Lorin Sutton et al. | |
| | Art Unit: 2134 | Examiner: Piotr Poltorak |
| | Confirmation No.: 5982 | |

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record
(Reg. No. 50, 630)

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34

Signature

Thomas A. Rozylowicz
Typed or printed name

(202) 783-5070
Telephone number

September 26, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 5 pages are submitted in addition to this Form and the Notice of Appeal.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant | : Lorin Sutton et al. | Art Unit | : 2134 |
| Serial No. | : 10/059,147 | Examiner | : Piotr Poltorak |
| Filed | : January 31, 2002 | Conf. No. | : 5982 |
| Title | : IDENTIFYING UNWANTED ELECTRONIC MESSAGES | | |

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 1-4, 6-12, 14, 15, 30-35, and 38-43 are now pending, with claim 1 being independent. Claims 1-4, 6-12, 14, 15, 30-35, and 38-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Paul (U.S. Patent No. 6,052,709) in view of Cotten (U.S. Patent No. 6,330,590). Applicant submits that these rejections fail to establish a prima facie case of obviousness because the rejections fail to point out a basis within the relied-upon Paul and Cotten references for teaching or suggesting at least one feature expressly recited in each of these claims.

Applicant asks the panel to review the issue highlighted below. Specifically, neither Paul, Cotten, nor any proper combination of the references describes or suggests monitoring a message associated with a security condition that reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected, and recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition.

Claim 1 recites a method of identifying unwanted messages. A payload portion of a message being communicated is inspected and characteristics of the payload portion are identified. The characteristics of the inspected payload portion of the message are compared with stored data indicating characteristics of at least one other message that has been inspected. Based on comparison results, a security condition is identified from among at least one of acceptable, unacceptable, and indeterminate states, and the message is processed based on the security condition. In particular, the message is rejected if the security condition associated with the message reflects the unacceptable state and the message is accepted if the security condition associated with the message reflects the acceptable state. If the security condition associated with the message reflects the indeterminate state, the message is monitored. Specifically, a location of the message is tracked and at least one other message is inspected subsequent to the processing of the message. The stored data is updated to indicate characteristics of the at least one other message that has been inspected and the security condition of the message is recategorized based on the updated stored data. Based on the security condition, the message is reprocessed.

The pending rejection of this claim, over Paul in view of Cotten, is not proper because the rejection fails to point out any basis in the references, taken alone or in combination, assuming the references may be combined, for teaching or suggesting "monitoring a message associated with a security condition that reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected, recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition."

The final Office Action recognizes that Paul fails to disclose identifying a security condition as reflecting an indeterminate state and, if the security condition associated with a message reflects the indeterminate state, monitoring the message. See final Office Action at page 6, paragraph 15 (relying on Cotten for disclosure of monitoring a message associated with a security condition that reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected,

recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition).[1]

However, none of the identified portions of Cotten disclose or suggest monitoring a message associated with a security condition that reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected, recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition.

In particular, Cotten at col. 4, lines 21-24 discloses identifying a bulk mailing signature code when three messages with the same signature code are detected going to three different e-mail addresses. Nothing in this portion of Cotten, however, discloses or suggests monitoring a message associated with a security condition that reflects the indeterminate state, much less monitoring a message in the manner recited in claim 1. Rather, this portion of Cotten merely discloses identifying a bulk mailing signature code for use in detecting unacceptable messages (e.g., SPAM) in future messages when a threshold number of messages with the same signature code have been sent to different recipients.

In addition, Cotten at col. 4, lines 35-36 refers to Fig. 3 and discloses "attaching a SPAM ID flag 37, at least temporarily, to the message for later processing." Although this portion of Cotten discloses later processing of a message identified as SPAM, nothing in Cotten discloses that the later processing includes anything more than delaying the processing of the message. In fact, as shown in Fig. 3, a message exiting signature comparator 36 with a SPAM ID flag 37 does nothing more than proceed to SPAM deletion mechanism 38, suggesting that the later processing of the message is merely delayed deletion of a message identified as SPAM. Had "later processing" included recategorizing the security condition of the message and reprocessing the message based on the security condition, messages marked with a SPAM ID flag 37 would proceed to a mechanism other than a SPAM deletion mechanism 38. Thus, this portion of Cotten fails to disclose or suggest monitoring a message associated with a security condition that

[1] Both the final Office Action and the advisory Action cite to portions of Cotten in order to reject these limitations. Specifically, the final Office action cites to Cotten at col. 4, lines 21-24, 35-36, and 46-58, while the advisory action cites to Cotten at col. 3, lines 46-58. See final Office Action at pages 6-7; advisory Action at page 2.

reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected, recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition.

Moreover, Cotten at col. 4, lines 46-58 describes, for example, a detection and removal center 43. The detection and removal center 43 either generates SPAM ID signatures 44 to be used by other messaging systems to identify SPAM messages received or removes SPAM messages from an e-mail stream to produce a spamless e-mail stream 45. However, the detection and removal center 43 does not monitor a message associated with a security condition that reflects the indeterminate state, much less do so in the manner recited in claim 1. Rather, the detection and removal center 43 is disclosed as merely performing a single detection and removal process to generate SPAM ID signatures or a spamless e-mail stream.

Furthermore, col. 3, lines 46-58, referred to by the advisory action, describes detecting the presence of SPAM when the system observes the same text included in multiple e-mail messages sent to different e-mail addresses. The advisory action states that "the messages are monitored by inspecting at least one of the message[s] subsequent to the message in question." Advisory action at page 2. However, this categorization of col. 3, lines 46-58 is incorrect. Rather, this cited portion of Cotten indicates that the text of the messages is monitored to determine if subsequent messages sent to different e-mail addresses include repeated text. Upon observation of different messages with repeated text, a signature identification code corresponding to the repeated text is stored for "further comparison, detection and processing of subsequent SPAM messages." Cotten at col. 3, lines 53-54 (emphasis added). Thus, the system of Cotten does not describe recategorizing the security condition of the message and reprocessing the message based on the security condition. Instead, the system of Cotten uses the signature identification code to process subsequent messages. As such, the system fully processes the initial messages with the repeated text and merely updates the data it uses to detect SPAM in new messages it receives. Nothing in Cotten discloses identifying a security condition of a message and then recategorizing the security condition for that message. Thus, this portion of Cotten fails to disclose or suggest monitoring a message associated with a security condition

that reflects the indeterminate state by tracking a location of the message, inspecting at least one other message subsequent to the processing of the message, updating the stored data to indicate characteristics of the at least one other message that has been inspected, recategorizing the security condition of the message based on the updated stored data, and reprocessing the message based on the security condition, as recited in claim 1.

Finally, the advisory Action merely asserts that Cotten implicitly discloses the features of tracking a location of the message and recategorizing the security condition of the message based on the updated stored data without citing to a specific portion of Cotten that discloses these features.

Because neither Paul nor Cotten, taken alone or in combination, assuming the references may be combined, disclose or suggest every limitation recited in claim 1, Applicant submits that the Examiner has not made a proper rejection under 35 U.S.C. § 103(a). Accordingly, the rejection of claim 1, and its dependent claims 2-4, 6-12, 14, 15, and 30-43, should be withdrawn.

For at least the reasons noted above, the rejections of record are clearly improper and without basis. Applicant submits that all of the claims are in condition for allowance. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 1/25/05

Thomas A. Rozylowicz
Reg. No. 50,620

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331